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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,898

01/09/2006

Jan-Jette Blange

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EXAMINER

NGUYEN, MAI T

ART UNIT

PAPER NUMBER

3671

MAIL DATE

DELIVERY MODE

02/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,898	Applicant(s) BLANGE, JAN-JETTE	
	Examiner MAI T. NGUYEN	Art Unit 3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 4 is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,12 and 13 is/are rejected.
- 7) ☒ Claim(s) 7-9,11,14-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/3/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,322,433.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a recirculation system of a tool for excavating an object using a filter opening that is essentially a gap created between a support surface of the excavator and another member which is considered the skirt in the application and the shield in the patent, both the skirt and shield are shown as element 43 in the figures which are essentially the same.

Claim Objections

3. Claim 2 is objected to because of the following informalities: “the entrance window” lacks antecedent basis and should be --an entrance window--, see line 3. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

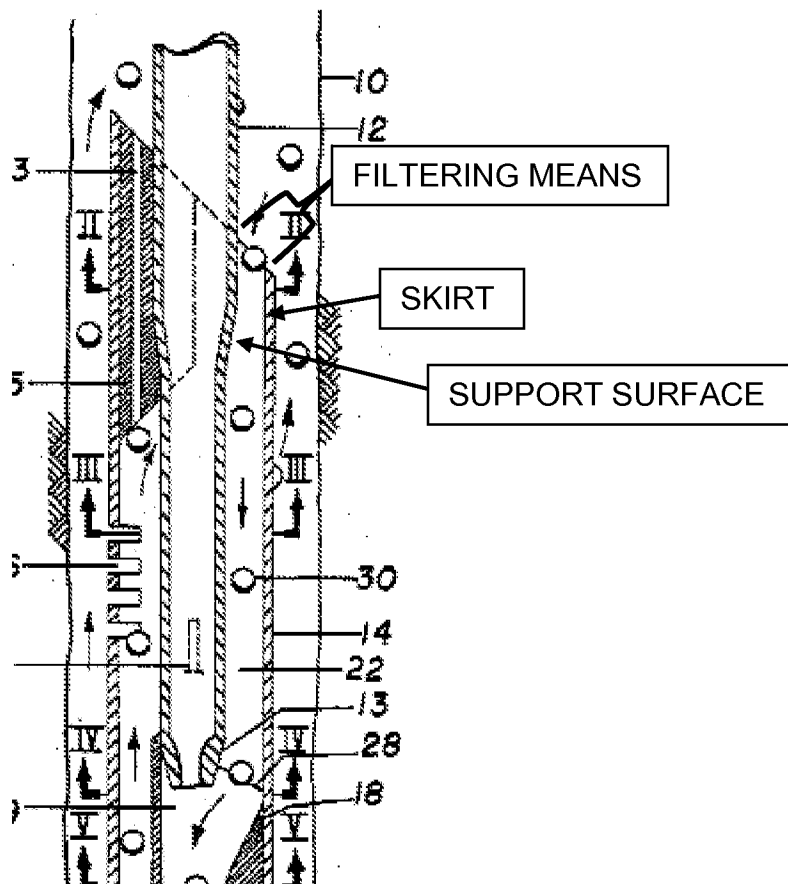
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 5, 6, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ortloff (US 2,779,571).
6. Regarding claim 1, Ortloff discloses a tool for excavating an object, as best seen in figure 1, comprising:
7. a jetting system having a nozzle means 17 arranged to receive a fluid and abrasive particles via an abrasive particle inlet 28, and arranged to impinge the object to be excavated with a jetted stream of the fluid mixed with the abrasive particles; a recirculation system arranged to recirculate at least some of the abrasive particles from a return stream, downstream of impingement of the jetted stream on the object to be excavated, back to the jetting system via the abrasive particle inlet, see column 1, lines 32-35; and a filtering means disposed in a path fluidly connecting the return stream with the abrasive particle inlet 28, wherein the filtering means includes an openings that is

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sized to keep the abrasive particle inlet 28 free from objects of the same size or larger than the abrasive particle inlet 28, which filtering means allows passage of the abrasive particles 30, see the following Figure A.

FIGURE A

8. Regarding claim 2, Ortloff discloses the filtering means, which is considered the openings between cylindrical members 12 and 14, is shaped or arranged such that the filtering means is impassable for a particle having the same projected size and shape as an entrance window of the abrasive particle inlet 28 and at the same time such that the one or more filter openings cannot be fully blocked by one such a particle, see figure 2.

9. Regarding claims 5 and 12, Ortloff discloses the recirculation system comprises a support surface, considered the outer surface of member 12, to guide the abrasive particles 30 towards the abrasive particle inlet 28, whereby the filtering means are provided in the form of a skirt, considered member 14, creating a filter opening in the form of a slit, considered the opening between members 12 and 14, between the skirt and support surface, see figures 1, 2 and A.

10. Regarding claims 6 and 13, Ortloff discloses the skirt comprises an arcuate member arranged to guide fluid from the return stream into the abrasive particle inlet 28 in a path along the support surface, wherein the arcuate member is a curved surface of member 14, see figures 1 and 2.

Allowable Subject Matter

11. Claims 3 and 4 are allowed.

12. Claims 7-9, 11, 14-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

13. Applicant's arguments with respect to claims 1, 2, 5, 6, 12 and 13 have been considered but are moot in view of the new ground(s) of rejection. Applicant has argued having "a filtering means that is separate from the inlet itself." Ortloff clearly shows the

filtering means, which is considered cylindrical members 12 and 14 and the annular space between the members, is separate from the inlet 28.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MAI T. NGUYEN whose telephone number is (571)272-7662. The examiner can normally be reached on Monday-Friday 8:00a-5:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on (571) 272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas B Will/
Supervisory Patent Examiner, Art Unit 3671

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